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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/939,905	09/29/1997	MARK GIJZEN	76.105	4378

23117 7590 12/17/2003

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/939,905	GIJZEN, MARK	
	Examiner	Art Unit	
	Ardin Marschel	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-33 and 36-39 is/are pending in the application.
~~4a) ☐ Claim(s) 5, 6, 34, & 35 have been canceled. is/are withdrawn from consideration.~~
- 5) ☒ Claim(s) 1-4, 8, 9, 11-29, 32, 33 and 36-39 is/are allowed.
- 6) ☒ Claim(s) 7, 10, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed 9/9/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, as well as an interference search, unfortunately the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

VAGUENESS AND INDEFINITENESS

Claims 7, 10, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 in line 2 cites then numbers 1-1532 but without citing them as nucleotide numbers. This contrasts with claim 8, for example, wherein the same numbers are referred to as "nucleotides 1-1532". Although it may be implied that nucleotides are meant in claim 7, such an implication falls short of being clear and concise as required under 35 U.S.C. 112, second paragraph. This same unclarity is present in claim 10, line 2. Claims 30 and 31 also contain this unclarity due to depending directly or indirectly from claim 7. Clarification via clearer claim wording is requested.

PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Products O 5878 and O 3378 of the 1990 Sigma Chemical Company Catalog.

It is noted that instant claim 7 is limited to an isolated DNA molecule which is substantially homologous to SEQ ID NO: 2 presumably in the 1-1532 nucleotide region. See the above rejection under 35 U.S.C. 112, second paragraph. The specification defines substantially homologous via conditions which result in "high stringency" hybridization. In order to obtain an equivalent definition, Dattagupta (P/N 6,596,490) is cited only to define what such high stringency hybridization may be reasonably evaluated as. In column 7, lines 29-37, such high stringency is operationally defined as being present if two nucleic acid sequences have 95%, 96%... or 100% of sequence identity. Consideration of SEQ ID NO: 2 reveals that several segments therein contain 7 "A" residues or 8 "T" residues. For example, 7 "A" residues are present at nucleotide positions 194-200 and at 214-220. Product O 3378 of the 1990 Sigma Chemical Company Catalog is a 7 "T" residue DNA which is therefore 100% hybridizable to such 7 "A" residues segments in the 1-1532 nucleotide region of instant SEQ ID NO: 2 thus anticipating instant claim 2. Similarly, an 8 residue "T" segment is present in instant SEQ ID NO: 2 at nucleotide positions 92-99. Product O 5878 of the 1990 Sigma Chemical Company Catalog hybridizes 100% to this segment thus also anticipating instant claim 7. It is noted that instant claim 7 lacks any limitation as to whether the hybridization criteria must correspond to the entirety of the claimed DNA or to the entirety of nucleotides 1-1532 of the instant SEQ ID NO: 2.

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POTENTIAL INTERFERENCE

On the enclosed PTO-892 the Patent Number 6,586,583 (Vierling, Jr.) is cited due to its containing claims to various lengthy segments of SEQ ID NO: 20 in the region wherein the nucleotides are numbered 1532 or less. It has been found that SEQ ID NO: 20 of Vierling, Jr., is 100% identical to instant SEQ ID NO: 2 regarding nucleotides 73-4655 and therefore may support an interference proceedings.

Claims 1-4, 8, 9, 11-29, 32, 33, and 36-39 are allowed over the prior art.

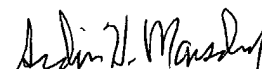
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 12, 2003


ARDIN H. MARSCHEL
PRIMARY EXAMINER